

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to the claims and the following comments.

In the Office Action mailed April 29, 2005, claims 1-3, 5 and 7-14 were examined and rejected as follows:

- Claim 1 was rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,451,054 to Orenstein (the "Orenstein patent").
- Claims 1-3, 5, 7-8, 10-12, and 14 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,653,640 to Shirley, Jr. (the "Shirley patent").
- Claim 9 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Shirley patent.
- Claim 13 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Shirley patent in view of U.S. Patent No. 3,926,439 to Chao et al. (the "Chao patent").

Applicants respectfully traverse these rejections.

By this Amendment, Applicants have amended independent claim 1 and its dependent claims 3, 5, and 7, to define the invention with greater particularity and thereby to highlight the distinctions of the present invention over the disclosures of the cited patents. Applicants also have amended claim 9 to be in independent form and to include all of the features previously acknowledged by the Examiner to be allowable, and they also have amended claim 10 to its original allowable form, dependent on claim 9. Applicants also have added new claims 22-30, which all depend from amended independent claim 1, and they have added new independent claim 31 and new claims 32-38, which all depend from claim 31. Claims 2, 4, 6, 8, and 14-21 have been canceled, without prejudice.

Thus, 26 claims are presented for consideration, including independent claim 1 and its dependent claims 3, 5, 7, 11-13, and 22-30; independent claim 9 and its

dependent claim 10; and independent claim 31 and its dependent claims 32-38. All of these claims are properly allowable.

The Invention

Before addressing the specific rejections of the claims, it will be helpful first to briefly summarize Applicants' claimed invention.

The invention resides in a poker table incorporating (1) a tabletop defining an opaque, planar playing surface, (2) one or more supports for the tabletop, (3) a light window, and (4) a light source configured to project light upwardly through the light window. The light window is defined to be translucent, planar, and coplanar with the playing surface, or it is defined to extend substantially around the playing surface and to have a generally oval shape. Preferably, the light window is configured to have *all* of these features. In addition, the light window optionally can extend around the *entire* playing surface, and it can be formed of milk-colored plexiglas.

In addition, the poker table can further incorporate a trough rigidly secured to the underside of the tabletop, for carrying the light source. The trough may be configured, for example, in a generally C-shape. A vertical riser of the trough can be fastened to the underside of the playing surface such that a portion of the trough, e.g., its base, extends outwardly from the outer edge of the playing surface. The trough can additionally include one or more access holes and/or one or more vent holes.

The tabletop can include a rigid base and an overlaying fabric pad. Further, the light source can include one or more fluorescent lights, and it can be configured to be illuminated continuously.

The § 102(b) Rejection of Claim 1 Based on the Orenstein Patent

As mentioned above, independent claim 1 was rejected under 35 U.S.C. § 102(b), as allegedly anticipated by the Orenstein patent. Applicants respectfully traverse

this rejection. The Orenstein patent fails to disclose a poker table having *all* of the features of claim 1, as amended.

The Orenstein patent discloses a poker "tournament" incorporating a table 10 having a plurality of card-receiving stations 12. Each such station includes a transparent window 20 formed in the table, and a card scanning apparatus 24 is located beneath each window, for viewing a face-down playing card placed over it. This enables a viewing audience to view the players' down cards.

Rejected independent claim 1 defines a poker table including (1) a tabletop defining a planar playing surface; (2) one or more supports for supporting the tabletop; (3) a planar light window coplanar with the plane of the playing surface, and (4) a light source configured to project light upwardly through the light window. In addition, by this Amendment, independent claim 1 has been amended to define the light window to be *translucent*. This, of course, means that the window transmits light in a diffuse manner, such that objects (e.g., a face-down playing card) cannot be seen clearly through it.

In rejecting independent claim 1 based on the Orenstein patent, the Examiner implicitly took the position that Orenstein's windows 20 correspond to the light window claim element. However, Orenstein's windows are necessarily *transparent*, not *translucent*. Otherwise, the card scanning apparatus 24 located beneath each window could not discern the players' down cards. Thus, Orenstein's poker "tournament" lacks the required *translucent* light window and therefore fails to anticipate amended independent claim 1.

For this reason alone, the rejection of independent claim 1, as allegedly anticipated by the Orenstein patent, is improper and should be withdrawn.

The § 102(b) Rejection of Claims 1-3, 5, 7-8, 10-12, and 14 Based on the Shirley Patent

Also as mentioned above, claims 1-3, 5, 7-8, 10-12, and 14 all were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by the Shirley patent. Applicants respectfully traverse this rejection. Rejected claims 2, 8, and 14 have been canceled.

without prejudice, and rejected claim 10 has been amended to depend from independent claim 9, which is discussed in a later section. Rejected independent claim 1 and its dependent claims 3, 5, 7, and 11-12 are discussed immediately below.

Regarding the Shirley patent and independent claim 1, the Examiner stated as follows, at pages 3-4 of the Office Action:

Shirley teaches the limitations of this claim except he fails to explicitly teach a poker table. Shirley however teaches, in col. 5, lines 36-61, that his invention may be employed in various other functions assembly and use and further teaches a surface (32) that is 'configured' for a poker tournament.

The Shirley patent discloses an illuminated pool game apparatus incorporating a pool table 30 having a flat playing surface 32, with a number of light units 34 located beneath the playing surface. Each light unit includes a light 40, a transparent lens 38, a motion sensor 42, and timer circuitry 44, which are configured to emit light for a prescribed limited time duration in response to sensing the motion of a ball on the playing surface above it. This emitted light projects upwardly through the lens and through an overlaying transparent layer covering the entire playing surface. In this manner, the light units, together, create a trail of light following the path of a ball moving along the playing surface. The transparent layer is specified (at column 2, lines 12-13) to cover "the entire playing surface" and (at column 5, lines 3-4) to be "constructed of an elastomeric material, but alternatively may be made of a transparent cloth."

By this Amendment, Applicants have amended independent claim 1 to define the poker table of the invention with greater particularity and thereby to highlight the distinctions of the present invention over the Shirley patent. Specifically, Applicants have amended claim 1 to specify that the poker table's playing surface is "opaque." This distinguishes over Shirley's *transparent* playing surface. Moreover, an *opaque* playing surface is entirely inconsistent with the entire purpose of Shirley's pool game apparatus, which is to provide illumination across the entirety of its playing surface.

For this reason alone, the Shirley patent fails to disclose a poker table incorporating *all* of the features of amended independent claim 1. Moreover, the Shirley patent fails to disclose a poker table incorporating the features set forth in rejected claims 3, 5, 7, and 11-12, which all depend from amended claim 1. For these reasons, the § 102 rejection of claims 1, 3, 5, 7, and 11-12 is improper and should be withdrawn.

The § 103(a) Rejection of Claim 9 Based on the Shirley Patent

Also as mentioned above, claim 9 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Shirley patent. Applicants respectfully traverse this rejection.

On page 2 of the Office Action, the Examiner commented that, because of Applicants' prior amendments to claims 9 and 10, "these claims are no longer considered allowable." In response, Applicants have now amended claim 9 to be in independent form and to incorporate all of the features previously recited in original claim 9 and its original parent claims. That form was acknowledged to be allowable in the Office Action mailed December 14, 2004. For this reason, claim 9, as amended, should now be allowed.

In addition, claim 10 has been amended back to its original allowable form, depending from claim 9. Claim 10, likewise should now be allowed.

**The § 103(a) Rejection of Claim 13 Based on
the Shirley Patent in View of the Chao Patent**

Also as mentioned above, claim 13 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Shirley patent in view of the Chao patent. Applicants respectfully traverse this rejection. These two patents fail to show or suggest the invention defined by claim 13.

Claim 13 depends from amended independent claim 1, discussed above, and more particularly defines the light source to include one or more fluorescent lights. Applicants agree with the Examiner's assertion that the Chao patent discloses a game apparatus incorporating linear fluorescent lights; however, Applicants respectfully disagree.

that it would have been obvious to have substituted Chao's linear fluorescent lights for Shirley's small incandescent light bulbs. This is because the use of fluorescent lights is inconsistent with the expressed purpose Shirley's pool table: "simulating an illuminated trail" as a ball rolls across the pool table. (Shirley patent, col. 2, line 14). To maximize this "illuminated trail" effect, the Shirley patent calls for a "multiplicity of light units each secured within an associated bore." (Shirley patent, col. 1, lines 66-67). The substitution of a Chao's large fluorescent light for Shirley's multiplicity of small lights would destroy the ability to simulate such an "illuminated trail." Thus, the Shirley patent teaches away from this combination.

For this reason, and for the reasons set forth above with respect to parent claim 1, the § 103 rejection of claim 13 is improper and should be withdrawn.

New Claims 22-38

Also by this Amendment, Applicants have added new claims 22-38. New claims 22-30 all depend from amended independent claim 1, while new claim 31 is independent and new claims 32-38 all depend from claim 31. These new claims each define a poker table that is not shown or suggest by the cited references, and they all are properly allowable.

More particularly, new claims 22-23 depend from dependent claim 7 and more particularly define the arm rest to include a rigid plate and a pad overlaying the plate's upper surface. Further, new claim 24 defines the translucent light window to be formed of milk-colored plexiglas, and new claim 25 defines the tabletop to include a rigid base and a fabric pad overlaying the base. New claim 26 defines the light source to be configured to be illuminated continuously. These features all are lacking in the disclosures of the cited references, and particularly the Orenstein and Shirley patents.

Further, new claim 27 defines the light window to extend substantially around the periphery of the playing surface, and new claim 28 defines the light window to extend around the *entire* periphery of the playing surface. New claim 29 defines the light

window to have a generally oval shape, and new claim 30 defines the light window to be discontinuous around the periphery of the playing surface. Again, these features all are lacking in the disclosures of the cited references, and particularly the Orenstein and Shirley patents.

New independent claim 31 defines a poker table including (1) a tabletop defining an opaque, planar playing surface; (2) one or more supports for supporting the tabletop; (3) a light window extending substantially around the periphery of the playing surface and having a generally oval shape, and (4) a light source configured to project light through the light window to the space above the playing surface.

The cited references, and particularly the Orenstein and Shirley patents, fail to show or suggest the poker table defined by new independent claim 31. In the particular case of the Shirley patent, it must be noted that even if the optical fibers 50 in the bumper 46 were analogized to the claimed light window, they would not form a "generally oval shape," as called for in claim 31. Moreover, it cannot be argued reasonably that skilled artisans would have been motivated to modify Shirley's optical fibers 50 to a form having the required generally oval shape; such a modification would be entirely inconsistent with Shirley's primary goal of providing a pool table, which necessarily has a *rectangular* shape.

New claim 32 depends from independent claim 31, defining the light window to be both planar and coplanar with the playing surface. Further, new claims 33 and 34 define the poker table further to include an arm rest extending around the outer periphery of the light window. New claim 35 defines the light window to be translucent, and new claim 36 defines the light window to be formed of milk-colored plexiglas. Again, these features all are lacking in the disclosures of the cited references, and particularly the Orenstein and Shirley patents.

Finally, new claim 37 defines the light window to extend around the *entire* periphery of the playing surface, and new claim 38 defines the light window to be

discontinuous around the periphery of the playing surface. Again, these features are lacking in the disclosures of the cited references, and particularly the Orenstein and Shirley patents.

No new matter has been introduced by the addition of these new claims. All of the features recited in these new claims were disclosed in the original written description. With particular regard to new claim 26, which calls for the light source to be "configured to be illuminated continuously," this feature is disclosed in the original written description inherently—a primary purpose of the invention is to provide lighting "which minimizes shadows during television taping." (Summary of the Invention, paragraph 0007). This purpose could not be achieved if the lighting were to be switched on and off during normal use of the poker table.

Conclusion

This application should now be in condition for allowance of claims 1, 3, 5, 7, 9-13, and 22-38. Issuance of a notice of allowance is respectfully requested. If the Examiner believes that a telephone conference with the Applicants' undersigned attorney might expedite the prosecution of this application, she is invited to call at the telephone number indicated below. Any additional fees due in connection with the filing of this Amendment should be charged to Deposit Account No. 19-1853.

Respectfully submitted,
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: 

James R. Brueggenmann
Registration No. 28,286

333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780 x4156
Facsimile: (213) 620-1398

W03-LA:JMW:70887032.3
102905

-13-

01YA-120318